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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/462,961	04/10/2000	JOHANNES KNOBLICH	GK-ZEI-3075	5712

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EXAMINER

ROBINSON, MARK A

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 11/29/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/462,961

Applicant(s)

KNOBLICH, JOHANNES

Examiner

Mark A. Robinson

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20-26 and 28-44 is/are pending in the application.
- 4a) Of the above claim(s) 21-24, 33-35 and 37-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20, 25, 26, 28-32, 36 and 40-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

*Claim Objections*

1. Claims 20 and 40 are objected to because of the following informalities: "the illumination direction" in claim 20 and "the plane of the two observation channels" in claim 40 lack antecedent basis. Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 20,25,26,28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Siersch (DE 9408066.6) made of record.

Siersch shows in fig. 3 an illumination arrangement for a stereomicroscope including an illumination channel(14/21) perpendicular to a plane containing the observation channels(13), with illumination being angled (path 23) with respect to the optical axis and being carried out by an end of a flexible light conductor(21) extending partially into the microscope housing and which is guided around the observation

Art Unit: 2872

optics(12,13) to illuminate a maximum field. Note also the optics(14) following the end of the conductor.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 36,40 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siersch made of record.

With respect to claim 36, Siersch does not expressly teach use of a cold light source. However, such light sources are well known in the art and use thereof would have been obvious to the ordinarily skilled artisan at the time of invention depending upon the type of observation to be performed of the sample and in order to take advantage of the benefits such sources are known to provide.

Siersch discloses the limitations of claims 40 and 44 as discussed above, but does not teach fluorescence excitation. However, fluorescence microscopy is well known in the art. It would have been obvious to the ordinarily skilled artisan at the time of invention to use a fluorescent source in Siersch's system in order to enable viewing of specimens responsive to ultraviolet radiation.

6. Claims 30-32, 41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siersch in view of Takagi et al, both made of record.

Siersch does not show adjustable or displaceable illumination optics as part of a zoom system coupled to the microscope's zoom system. However, such systems are known and an example is shown by Takagi as discussed previously (also note Takagi's manual control 43). It would have been obvious to the ordinarily skilled artisan at the time of invention to include Takagi's zoom arrangements in Siersch's microscope system in order to allow for illumination and viewing of a sample using various magnifications.

7. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siersch in view of Takagi et al and Greenberg, all made of record.

Siersch does not show optics which are swivelable as part of a zoom illumination system. However, Takagi shows a zoom illumination system as discussed above, and Greenberg shows swivelable illumination optics (see figs. 1A-1C). It would have been obvious to the ordinarily skilled artisan at the time of invention to include both the zoom system of Takagi and the swivelable illumination optics of Greenberg in Siersch's microscope system in order to provide for viewing of the sample

at different magnifications and at different illumination angles, as taught by these references.

### *Response to Arguments*

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant has also stated that the examiner has not provided an explanation of the alleged inconsistency "as to why claim 20 is now not deemed to be generic."

In response, applicant should note that the examiner has not indicated a change in his interpretation of claim 20. Both claims 20 and 25 are generic. Accordingly, these two claims read on and are examined with the elected species. Claim 25 was specifically mentioned in the office action dated 3/30/01 because this claim was not mentioned in the original election requirement.

### *Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is

Art Unit: 2872

reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (703) 305-3506.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached at (703) 308-1687. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Art Unit: 2872

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to read 'Mark Robinson', is written over a horizontal line.

Mark Robinson

Patent Examiner

Art Unit 2872

11/09/01